

Appl. No. 10/771,406
Amendment dated: February 21, 2006
Reply to OA of: November 22, 2005

REMARKS

Applicants acknowledge with appreciation the indication that claim 16 is patentable if it is re-written in independent form. Claim 16 depends on claim 13 which depends on claim 12 which depends on claim 1. The newly amended claim 1 is a combination of claims 1, 12 and 16, and should also be patentable without incorporating the features of claim 13, because claim 13 is merely related to the heating temperature of the biological waste sludge, not to the claimed apparatus directly. Accordingly, Applicants believe that claim 1 as now amended is allowable and claims directly and indirectly dependent thereon are also allowable.

Applicants most respectfully submit that all of the claims now present in the application, are in full compliance with 35 U.S.C. 112 and clearly patentable over the references of record. The claims now present in the application are amended claim 1, original claims 2-11, currently amended claim 13 and original claims 14, 15 and 17. Claims 12 and 16 have been cancelled without prejudice or disclaimer.

The rejection of claims 1-3, 7, 8 and 9 under 35 U.S.C. 102(b) as anticipated by Yum or Daigger has been carefully considered but is most respectfully traversed in view of the amendments to the claims. The limitations from claims 12 and 16 have been added to claim 1. The added limitations were contained in claims not included in the anticipation rejection.

Applicants wish to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the

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claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

Accordingly, it is most respectfully requested that these rejections be withdrawn in view of the amendments to the claims and the above comments.

The rejection of claims 10-12, 14 and 15 under 35 U.S.C. 103(a) as obvious over a Daigger has been carefully considered but is most respectfully traversed in view of the amendments to the claims and the following comments.

The rejection of claims 12-13 and 17 under 35 U.S.C. 103(a) as obvious over Daigger in view of Tonnelli and of claim 4 over Yum or Daiggers as applied to claim 3, further in view of Onishi has been carefully considered. These rejections are most respectfully traversed. Claim 5 has been rejected as obvious over Yum or Daigger as applied to claim 1 above, further in view of Goldsmith. This rejection has also been carefully considered but is most respectfully traversed.

Applicants wish to direct the Examiner's attention to the basic requirements of a *prima facie* case of obviousness as set forth in the MPEP § 2143. This section states that to establish a *prima facie* case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an

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independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence presented by applicant and the citation of *In re Soni* for error in not considering evidence presented in the specification. Accordingly, it is most respectfully requested that this rejection be withdrawn.

Claim 16 has not been included in any of the rejections on the ground of obviousness. The limitations from claims 12 and 16 have been added to claim 1 and all of the claims are either directly or indirectly dependent on claim 1 thereby obviating each of the rejections under 35 USC 103. These limitations include that the hydrolysis reactor is provided with an agitator for stirring the biological waste sludge, and a heater for heating the biological waste sludge and that the neutralization reactor is provided with an agitator for stirring the hydrolyzed sludge, and a heat exchanger for the lowering temperature of the hydrolyzed sludge. This additional combination of features is not suggested by the prior art relied upon in the rejection.

Moreover, the necessary motivation to combine the references and arrive at the claimed invention is not present, except in Applicants' specification. Applicants' teaching may not be used as a teaching reference. *In re Fritch*, 23 USPQ 1780, 1784(Fed Cir. 1992) ("It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.). Accordingly, it is most respectfully requested that these rejections be withdrawn.

Additionally, Applicants hereby submit the required certified copy of priority document number 092120581, benefit of which is claimed in the declaration of this application. The Examiner is most respectfully requested to acknowledge receipt of this certified copy in the next Official Action.

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In view of the above comments and further amendments to the claims favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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